

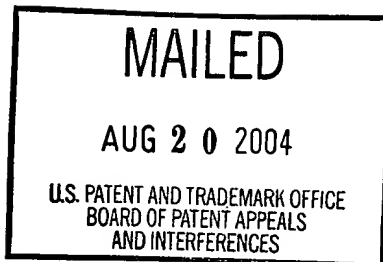
The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY J. MANCUSO and KEVIN GERACE



Appeal No. 2004-1602
Application No. 09/954,766

ON BRIEF

Before GARRIS, WALTZ, and JEFFREY T. SMITH, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 1 through 12, which are all of the claims pending in this application (see the Brief, page 2). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a free-standing coil reel hold-down device which comprises a base plate secured to a floor, a snubber arm pivotably mounted to the base plate including first and second sections disposed at an obtuse angle with respect to each other, and a stand-alone means for

Appeal No. 2004-1602
Application No. 09/954,766

effecting a pivoting movement of the snubber arm relative to the base plate (Brief, page 2).

Appellants state that the claims do not stand or fall together (Brief, page 3). Appellants present reasonably specific, substantive reasons for the separate patentability of several claims (e.g., see the Brief, pages 8-9; Answer, page 2, ¶(7)). We consider these claims separately to the extent appellants have presented arguments for any individual claims. See 37 CFR § 1.192(c)(7)(2000); and *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). Representative independent claim 1 is reproduced below:

1. A free-standing coil reel hold-down device, comprising:
a base plate operatively arranged to be secured to a floor;

a snubber arm pivotably mounted to said base plate and arranged for pivoting rotation about a pivot point, said snubber arm including a first section and a second section disposed at an obtuse angle with respect to one another; and,

a stand-alone means for effecting a pivoting movement of said snubber arm relative to said base plate.

The examiner has relied upon the following prior art as evidence in support of the rejections on appeal:

Orii	4,589,605	May 20, 1986
Rodriguez et al. (Rodriguez)	5,330,119	Jul. 19, 1994

Claims 1-3, 6 and 10 stand rejected under 35 U.S.C. § 102(b) as anticipated by Rodriguez (Answer, page 4). Claims 4-5 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Rodriguez in view of Orii (*id.*). Claims 7-9, 11 and 12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Rodriguez (Answer, page 5). We *affirm* all of the rejections on appeal essentially for the reasons stated in the Answer and those reasons set forth below.

OPINION

A. The Rejection under § 102(b)

The examiner finds that Rodriguez discloses a free-standing coil reel hold-down device 266 comprising a base plate 268 secured to floor 42, a pivotal snubber arm 270 mounted to the base plate, with the snubber arm 270 having two sections disposed at an obtuse angle with respect to each other, and a stand-alone means 274 for effecting a pivoting movement of the snubber arm relative to the base plate (Answer, page 4, citing Figure 9 of Rodriguez as well as col. 10, 11. 6-7, 9-11 and 11-14).

Appellants argue that Rodriguez does not contain each and every element of the claimed invention (Brief, page 4). Specifically, appellants argue that Rodriguez does not disclose a "Snubber Arm Including a First Section and a Second Section" as required by claim 1 since the reference features a one-piece

Appeal No. 2004-1602
Application No. 09/954,766

bellcrank arm 270 (*id.*). Appellants submit that this one-piece construction makes it impossible to have an obtuse angle in the arm of Rodriguez, and the relatively short length of the one-piece bellcrank arm results in a snubber contacting the coil on the side, not the top as in appellants' invention (Brief, pages 4-5 and 7).

These arguments are not persuasive. As correctly construed by the examiner (Answer, page 7), the term "section" as recited in claim 1 on appeal does not limit the snubber arm to any number of pieces since even a one-piece construction could have multiple sections. See *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) ("the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art," when read in light of the specification). Appellants' specification does not define "sections" as separate pieces (see the specification, pages 7 and 9). Giving the ordinary meaning to the word "section," which is "[a] part or piece of something," there is no limitation that each section must be a separate piece.¹ In other words, appellants are arguing

¹See *Webster's II, New Riverside University Dictionary*, p. 1055, The Riverside Publishing Co., 1984 (a copy of this page is attached to this decision).

limitations that are not recited in the claims, namely the claims do not recite that the snubber arm is constructed of two separate pieces. See *In re Huang*, 100 F.3d 135, 139, 40 USPQ2d 1685, 1688 (Fed. Cir. 1996). Furthermore, as clearly shown by Figure 9 of Rodriguez, the snubber arm has two sections at an obtuse angle with respect to each other (see the bellcrank arm 270 with an unnumbered pivotal point establishing two sections). Finally, we note that claim 1 on appeal does not recite whether the snubber contacts the coil on the side or the top, and thus appellants are again arguing limitations not found in the claim.

Appellants also argue that Rodriguez does not disclose the claimed element of "Effecting a Pivoting Movement of Said Snubber Arm Relative to said Base Plate" but teaches bellcrank arm 270 is pivotally mounted at a point intermediate its ends on a flange 276 (Brief, pages 5-6). Appellants further argue that Rodriguez does not disclose "A Stand-Alone Means For Effecting a Pivoting Movement" as required by claim 1 on appeal (Brief, page 6).

These arguments are not persuasive. As correctly noted by the examiner (Answer, page 7), the exact location of the pivot point is not recited in claim 1 on appeal. Accordingly, this argument is to no avail since it concerns limitations not found in claim 1 on

appeal. See *In re Huang, supra*. As further noted by the examiner (*id.*), the snubber of Rodriguez is mounted to a floor separate from but adjacent to the arbor holding the coil and thus is "free-standing." It is noted that the snubber of Rodriguez is in the same position as disclosed by appellants, i.e., it is not "integral" with the coil and thus "free-standing" as defined by appellants' specification (specification, page 6, ll. 9-13). See *In re Morris, supra*.

Appellants argue that the Exhibit 1 demonstration makes apparent the additional functional benefits derived from the structural features of the present invention (Brief, page 7). This argument is not well taken since unexpected results are not relevant to this rejection based on section 102(b). See *In re Malagari*, 499 F.2d 1297, 1302, 182 USPQ 549, 553 (CCPA 1974). Furthermore, appellants have not established that the Exhibit 1 demonstration involves the same device as now claimed.

Other than reiterating the limitations of claims 2, 3, 6 and 10, appellants' sole argument with respect to these dependent claims is that there is no teaching in Rodriguez regarding the length of the bellcrank arm 270, as required by claim 10 on appeal (Brief, page 8). As correctly found by the examiner, one section of the bellcrank arm 270 is "approximately" three times the length

Appeal No. 2004-1602
Application No. 09/954,766

of the second section, noting that claim 10 does not specify which section is first or second (Answer, page 4, citing Figure 9 of Rodriguez). We note that terms of degree such as "approximately" allow for some latitude on either side of the recited value. See *Eiselstein v. Frank*, 52 F.3d 1035, 1040, 34 USPQ2d 1467, 1471 (Fed. Cir. 1995); and *In re Woodruff*, 919 F.2d 1575, 1577, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established that each and every limitation of the claims is described by Rodriguez within the meaning of section 102(b). Accordingly, we affirm the rejection of claims 1-3, 6 and 10 under section 102(b) over Rodriguez.

B. The Rejections under § 103(a)

With regard to the rejection of claims 7-9 and 11-12 over Rodriguez (Answer, page 5), appellants present the same arguments with respect to Rodriguez as well as arguing the teachings of Orii (Brief, page 12). However, Orii has not been applied against claims 7-9 and 11-12. Therefore appellants' argument regarding the "combination of prior art references" is not well taken (Brief, page 13).

Appellants argue that the examiner has failed to appreciate the significance of the particular angle between sections of the

Appeal No. 2004-1602
Application No. 09/954,766

arm and the particular amount of pivoting movement (Brief, page 12). However, as discussed above with respect to the rejection under section 102(b), Rodriguez teaches an obtuse angle between sections of the bellcrank arm 270, as well as pivotal movement (see Figure 9). We note that appellants have failed to establish any criticality for the particular values of the obtuse angle or the amount of pivotal movement. See *In re Woodruff*, *supra*.

With regard to the rejection of claims 4 and 5, appellants argue that even if Orii teaches a snubber in the form of a roller, this reference cannot cure the deficiencies of Rodriguez (Brief, paragraph bridging pages 9-10). This argument is not persuasive for reasons discussed above.

Appellants argue that Rodriguez "teaches away" from the present invention by requiring a plurality of large diameter coils placed in a fixed feeding position (Brief, page 10). This argument is not well taken since claims 4 and 5 do not exclude any of these limitations, and appellants have not demonstrated how this disclosure of Rodriguez "teaches away" from the invention as claimed.

Appellants argue that Orii is directed to uncoiling a reel which "teaches away" from the coil reel hold down device of the present invention, and further this reference fails to disclose a

Appeal No. 2004-1602
Application No. 09/954,766

bisectonal arm with an obtuse angle and stand-alone means (Brief, page 10). These arguments are not well taken since, as noted by the examiner (Answer, page 9), Orii is directed to the same type of device as claimed by appellants and disclosed by Rodriguez, namely a coil reel hold down device. Appellants' argument that Orii does not contain all the claimed features is misplaced since the test for obviousness is not what each reference discloses or suggests but what the combined teachings of the prior art references would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Finally, appellants argue that the affidavit under 37 CFR § 1.132 shows secondary evidence of commercial success and thus necessitates a conclusion that the invention is not obvious (Brief, pages 10-11 and 13). This evidence is not convincing nor sufficient to rebut the *prima facie* case of obviousness established by the examiner since it merely consists of a sales report. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996) ("Evidence related solely to the number of units sold provides a very weak showing of commercial success, if any. [Citation omitted]."). Furthermore, appellants have not established that these sales are significant, constituting a significant share of the market, and are due only to the unique characteristics of the

Appeal No. 2004-1602
Application No. 09/954,766

claimed invention. See *In re Huang, supra*. Finally, we note that these sales figures were only shown for one month in each of two years.

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a *prima facie* case of obviousness based on the reference evidence. Based on the totality of the record, including due consideration of appellants' arguments and evidence, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Accordingly, we affirm both rejections on appeal based on section 103(a).

C. Summary

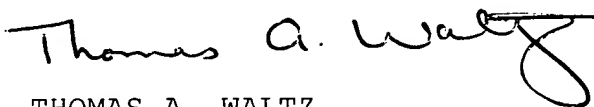
The rejection of claims 1-3, 6 and 10 under 35 U.S.C. § 102(b) over Rodriguez is affirmed. The rejection of claims 4-5 under 35 U.S.C. § 103(a) over Rodriguez in view of Orii is affirmed. The rejection of claims 7-9 and 11-12 under 35 U.S.C. § 103(a) over Rodriguez is affirmed.

Appeal No. 2004-1602
Application No. 09/954,766


No time period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


BRADLEY R. GARRIS
Administrative Patent Judge)
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THOMAS A. WALTZ
Administrative Patent Judge)
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BOARD OF PATENT
APPEALS
AND
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JEFFREY T. SMITH
Administrative Patent Judge)
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TAW/jrg

Appeal No. 2004-1602
Application No. 09/954,766

SIMPSON & SIMPSON, PLLC
5555 MAIN STREET
WILLIAMSVILLE, NY 14221-5406